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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,867	07/28/2003	Henri Hannula	0365-0568P	3629
2292 7590 11/13/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
DOWE, KATHERINE MARIE				
ART UNIT		PAPER NUMBER		
3734				
NOTIFICATION DATE		DELIVERY MODE		
11/13/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

## Application No.

10/627,867

## Applicant(s)

HANNULA ET AL.

## Examiner

KATHERINE M. DOWE

## Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following is a complete response to the amendment filed July 7, 2009.
2. Claims 26-49 are currently pending.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 26-32, 35-43, 46, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferre et al. (US 6,694,167). Ferre et al. disclose a stereotactic device comprising a frame (34) configured to mount on the nasion of a subject extending frontally below the eyes to end positions of the frame that are in front of the face of subject and outside a field of vision of the subject such that the frame is capable of contacting only the nose of the subject and located in front of a plane defined by the eyes of the subject without immobilizing the subject's head (Figure 1). At least three fiducial markers (116) are mounted on the frame and configured to define a position of the frame with respect to the subject, wherein at least three of the fiducial markers are in different vertical lines from one another, the vertical lines being perpendicular to the frame (Figure 18, col 8, ll 25-32). The frame includes a nasion relator portion comprising a nose piece (32) compliant with a contour of the subject's nose. A supporting element (30) is attached to the end positions of the frame to secure the device to the subject. Ferre et al. further discloses a diagnostic method comprising mounting the frame on the nasion of the subject, defining a position of the frame with

respect to the subject via the three fiducial markers, and performing a diagnosis based on the defined position of the frame with respect to the subject (col 2, ll 19-37; col 8, ln 3 – col 9, ln 26).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 33, 34, 44, 45, 48, and 49 rejected under 35 U.S.C. 103(a) as being unpatentable over Ferre et al. (US 6,694,167), as applied to claims 32 and 43 above, in view of Anthony (US 6,758,218). Ferre et al. disclose the invention substantially as claimed as shown above including an adjustable supporting element (30) to secure the frame to the subject. However, Ferre et al. do not disclose the supporting element is an adjustable band that passes behind the subject's head, neck, or shoulders such that the supporting element forms a closed loop. Anthony discloses a similar device with a frame (500) configured to be mounted on a subject's face (Figure 9) and teaches the frame is fixed on the subject with an adjustable band (510) that extends laterally from the frame and passes behind the subject's head (col 23, ll 22-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Ferre et al. such that the supporting element comprised an adjustable band that passes laterally from the frame (34) and behind the subject's head to more securely hold the frame in place on the subject's face. When the device of Ferre et al. is modified in this manner, the supporting element would also be configured

to be located only between an eye level and a neck level of the subject when the frame is mounted on the nasion of the subject.

### ***Response to Arguments***

7. Applicant's arguments filed July 7, 2009 have been fully considered but they are not persuasive. Applicant argues Ferre et al. teaches some fiducial markers are in the same vertical line and thus Ferre et al. do not teach that at least three fiducial markers are in different vertical lines from one another. The examiner respectfully disagrees and notes Applicant acknowledges the markers are arranged in different vertical lines: "For example, the three fiducial balls on the left side are in one vertical line, and the three fiducial balls on the right side are in another vertical line" (see lines 3-4 on page 8 of Remarks). The claim merely requires at least three markers be along different vertical lines, of which Ferre et al. clearly meets with the markers (116) shown in Figure 18. The claim does not preclude additional markers from being along the same vertical lines. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. In response to applicant's argument that Anthony is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this

case, Anthony is pertinent to solving the problem of securing a frame to the face of a subject.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KATHERINE M. DOWE** whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe  
November 4, 2009

/K. M. D./  
Examiner, Art Unit 3734

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734